

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/028,913

REMARKS

Claims 4-8 and 11-20 are all the claims pending in the application. Claims 4-8 and 11-17 presently stand rejected. By this Amendment, Applicant adds claims 18-20.

I. Preliminary Matters

Applicant thanks the Examiner for initialing the references listed on Form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on October 28, 2004.

II. Summary of the Office Action

The Examiner withdrew the previous rejections. The Examiner, however, found new grounds for rejecting the claims. In particular, claims 4 and 17 are rejected under 35 U.S.C. § 102(b) and claims 5-8 and 12-16 are rejected under 35 U.S.C. § 103(a).

III. Rejections under 35 U.S.C. § 102

Claims 4 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,684,715 to Palmer (hereinafter “Palmer”). Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider the rejection in view of the following comments.

Of these rejected claims, only claim 4 is independent. Independent claim 4, among a number of unique features recites “an image detector for detecting a static image at a corresponding time based on point time information transmitted from said user terminal.” The Examiner alleges that Palmer discloses this unique feature of claim 1 (see page 2 of the Office Action). Applicant respectfully disagrees.

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To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is *identically disclosed or described in the prior art*. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

For example, an illustrative, non-limiting embodiment of the present invention discloses the following system for finding links within moving images. When the user selects a point in the moving image, the user terminal detects the point coordinate information (x, y) and the point time information (t) of the user selection. The server recreates the static image that appeared on the user display during said selection based on the point time information (t) received from the user terminal. After recreating the static image, the server uses the point coordinate information (x, y) received from the user terminal to detect a specific portion of the static image (a particular shape) where the user selection was made. At the same time, using the point coordinate information (x, y), the server pulls up or calculates the linking information using the link point information storage.

In particular, when a certain shape within the image, *i.e.* a specific portion of the image, moves abruptly at a point of time selected by the user, the storage will have the linking information stored therein. On the other hand, when the movement is linear, not abrupt, the server will calculate the linking information for this specific portion using the linking information stored therein (*e.g.*, the linking information will include a starting point of the movement and the ending point of the movement and based on this, the linking information for a

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particular time will be interpolated). Finally, the server checks whether the selected shape (particular portion of the image selected by the user) has linking information as determined by the link point detector. When the linking information is found, the related information is displayed on the user terminal. As a result, the volume of information that needs to be stored is reduced. It becomes unnecessary to store link information on all point times and link information on all point coordinates. This illustrative, non-limiting embodiment is provided by way of an example only and is not intended to limit the scope of the claims in any way.

Palmer relates to an interactive video system by which an operator is able to select an object moving in a video sequence and by which the interactive video system is notified which object was selected so as to take an appropriate action (*see Abstract*). In particular, Palmer discloses that in response to a user command, communicated from interactive video application program 81, an event interpreter 85 controls the video source 82 to playout successive frames of the video information. The frame information is displayed on display 12 via video controller 36. In synchronism with the playout of the video information from the video source 82, the synchronizer 91 feeds the file 86 of the video object descriptors to the event interpreter 85 (Fig. 5; col. 8, lines 4 to 11).

In Palmer, the event interpreter 85 extracts a list of valid and active video objects from the video object descriptors and stores those valid and active video objects in the list 87. At the same time, the event interpreter 85 stores an action map corresponding to actions which are taken when a video object currently displayed on a display 12 is selected by the user, *i.e.*, the cursor position information is fed to the event interpreter 85 that employs a matcher to match when a

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cursor selection corresponds to a selection of a video object in the list 87 of the active video objects. When a match is detected, the event interpreter 85 accesses the action map 89 so as to initiate an activation of the action attributes stored in the selected video object descriptor (Fig. 5, col. 8, lines 11 to 26).

In Palmer, however, the synchronizer 91 is provided so as to afford synchronization between the layout of successive frames of video information from the video source 82 with the layout of video object descriptors from the file 86 of the video object descriptors. The synchronization is needed so as to ensure that the list 87 of active objects stored by the event interpreter 85 corresponds to the objects being displayed on the display 12 (Fig. 5, col. 7, lines 64 to 68). That is, in Palmer, each frame being displayed is matched with an object descriptors from a description file. Since each frame being displayed is synchronized with the object descriptors, there is no need for an image detector as set forth in claim 4. In other words, there is no need to detect a static image based on the point time information transmitted from the user terminal. Instead, Palmer simply discloses that each frame being displayed is matched up with the object descriptors from the description file. In short, Palmer fails to teach or suggest an image detector that will detect a static image based on the point time information transmitted from the user terminal.

Therefore, “an image detector for detecting a static image at a corresponding time based on point time information transmitted from said user terminal,” as set forth in claim 4 is not suggested or taught by Palmer, which lacks detecting a static image based on point time information transmitted from the user terminal. Instead, Palmer simply uses a synchronizer

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which synchronizes each frame being displayed with a description of objects from the description file. For at least these exemplary reasons, claim 4 is patentably distinguishable from Palmer. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 4 and its dependent claim 17.

IV. Rejections under 35 U.S.C. § 103

Claims 5-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of U.S. Patent No. 5,918,012 to Astiz et al. (hereinafter “Astiz”). Applicant respectfully traverses in view of the following comments.

Of the rejected claims, claims 5-8 depend on claim 4. Applicant has already demonstrated that Palmer does not teach or suggest unique features recited in the independent claim 4. Astiz clearly fails to teach or suggest the unique features of claim 4, as acknowledged by the Examiner by withdrawing the previous rejection and as detailed in the Amendment under 37 C.F.R. § 1.116 filed on November 4, 2004. That is, Astiz does not teach or suggest detecting a static image. In short, Astiz does not cure the deficient teachings of Palmer. Therefore, claims 5-8 are patentable at least by virtue of their dependency on the independent claim 4.

In addition, claims 5-8 are patentable because there is no motivation to combine the references in the manner suggested by the Examiner.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is *casting the mind back to the time of invention*, to consider the thinking of one of ordinary skill in the art, *guided only by the prior art references and the then-accepted wisdom in the field*. See *In re Kotzab* , 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembicza*k, 175 F.3d

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994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)), (emphasis added). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (*quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998), (emphasis added). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, ***the showing of combinability, in whatever form, must nevertheless be “clear and particular”***. *Winner International Royalty Corporation v. Ching-Rong Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000), (emphasis

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added). In the present case, there is no motivation to combine the references in the manner suggested by the Examiner.

In the present case, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine the references because utilizing the teachings of Astiz would allow Palmer “to have a better way to present user with interactive hyper-link related information” (see page 4 of the Office Action). This rationale is not understood. That is, at the very least it is unclear how Astiz’s internet system “would better” the Palmer’s interactive video system. Applicant respectfully points out that the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). *A broad conclusionary statement, standing alone without support, is not “evidence.” Id.; see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). The rationale that Astiz “would better” the system of Palmer is not evidence that would establish a *prima facie* case of obviousness.

Moreover, Astiz relates to a network data processing system (an internet system), whereas Palmer relates to a video system (a TV system). One of ordinary skill in the art would not have turned to the teaching Astiz to “better” the system of Palmer. In short, Applicant respectfully submits that there is no motivation to combine the references in the manner suggested by the Examiner.

Claims 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer in view of U.S. Patent No. 6,570,586 to Kamen et al. (hereinafter “Kamen”). Applicant respectfully traverses in view of the following comments. Of the rejected claims, claims 12-15

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depend on claim 4. Applicant has already demonstrated that Palmer does not teach or suggest unique features recited in the independent claim 4. Kamen is being cited only for its teachings of an interpolation technique (see page 7 of the Office Action) and (col. 2, lines 13 to 45 of Kamen). That is, Kamen does not teach or suggest detecting a static image based on point information. As such, Kamen clearly fails to cure the deficient teachings of Palmer. Therefore, claims 12-15 are patentable at least by virtue of their dependency on claim 4.

In addition, dependent claim 12 recites “said linking point storage only stores a link destination for every point designating abrupt change in a movement of a specific portion of an image.” The Examiner acknowledges that Palmer does not teach or suggest at least this unique feature of claim 12 (see page 7 of the Office Action). The Examiner, however, alleges that Kamen cures the deficient teachings of Palmer. Applicant respectfully disagrees.

The Examiner is relying on Fig. 3 of Kamen. Fig. 3 of Kamen, however, illustrates the y coordinate of the active area vs. frame number. Similar calculations are performed for the x coordinate of the active area, and the size of the active area. That is, the size of the active area can increase or decrease, e.g. depending upon whether the object associated with the active area moves toward or away from the camera. (col. 3, lines 56 to 62). The graph depicted in Fig. 3 shows “an active point for every tenth frames” (col. 3, lines 41 to 48). Clearly, Fig. 3 of Kamen does not teach or suggest having a link point destination for each abrupt change in movement. Indeed, Fig. 3 depicts an active point based on the number of the frame and not based on the abrupt movement of the object.

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In Kamen, there is no teaching or suggestion that a link destination will be stored for each abrupt change in a movement of an object. In fact, Kamen simply discloses linear interpolation, where location, size, and shape will be stored for some frames and interpolated for other frames, e.g., every ten frames (col. 4, lines 16 to 34). In short, Kamen does no teaching or suggest having a link point destination for each abrupt change in the movement of the object. Kamen does not cure the deficient teachings of Palmer. For at least this additional reason, claim 12 is patentable over the combined teachings of Palmer and Kamen.

Finally, claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer and Astiz in view of Kamen. Applicant respectfully traverses this rejection in view of the following comments.

Claim 16 depends on claim 4. Applicant has already demonstrated that the combined teachings of Palmer and Astiz and the combined teachings of Palmer and Kamen do not teach or suggest unique features recited in the independent claim 4. Applicant respectfully submits that the combined teachings of Palmer, Astiz, and Kamen, taken alone or in any conceivable combination fail to teach or suggest the image detector as set forth in claim 4. That is, Astiz and Kamen fail to cure the deficient teachings of Palmer. Therefore, claim 16 is patentable at least by virtue of its dependency on the independent claim 4.

V. New Claim

In order to provide more varied protection, Applicant adds claims 18-20. Claims 18-20 are patentable at least by virtue of their dependency on claim 4.

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VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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